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John W. Renner			GARTLAND, SCOTT D	
Renner Otto Boisselle & Sklar LLP				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,185	<b>Applicant(s)</b> OH, HYUN-SEUNG
	<b>Examiner</b> SCOTT D. GARTLAND	<b>Art Unit</b> 4115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 16 June 2005.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-23 and 25-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-23, 25-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 June 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 6-16-2005

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

This communication is in response to the application and preliminary amendments filed on June 16, 2005. Claims 1-23 and 25-34 are pending and presented for examination, claims 3, 5-6, 10, 17-18, and 23 currently amended, new claims 28-34 added and claim 24 cancelled.

##### ***Priority***

Acknowledgment is made of applicant's claim for priority as national stage entry for PCT International Application PCT/KR03/02746, filed on December 15, 2003.

Acknowledgment is also made of applicant's claim for foreign priority to Korean Application 10-2002-0080773, filed on December 17, 2002 and a certified copy of this Korean application has been placed in the file.

##### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on June 16, 2005 was filed after the mailing date of the application on June 16, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

##### ***Specification***

The abstract of the disclosure is objected to because it essentially just recites the first and twenty-fifth claims. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 recites the limitation "accumulated point(s)" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 10-16, 18-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent Application Publication No. 2003/0050837, hereafter Kim) in view of Chavez, Jr. et al. (U.S. Patent No. 6,603,844, hereafter Chavez).

As to claim 1, Kim discloses a method for providing an advertisement service using a ring back tone in a server of a common carrier, the method comprising:

receiving a call request signal from an originator terminal (paragraph 0019, users at an outgoing call signal side, and when an existing terminal is used; paragraphs hereafter cited by number only);

extracting an advertisement message from an advertisement database (0008, accessing an advertisement provider, downloading and storing the advertisement; also 0019, system operator providing advertisement download service and includes advertisement database);

transmitting the advertisement message to the originator terminal (0008, outputting the advertisement as ringing tone to a caller);

interrupting transmission of the advertisement message when a call connection is made between the originator terminal and a recipient terminal (0008, interrupting the advertisement if call is connected);

extracting advertisement data corresponding to the advertisement message (0008, counting the number of listening and watching of an advertisement); and

transmitting the extracted advertisement data to the originator terminal (0032, accumulated points are provided).

Kim, however, does not explicitly disclose the extraction being when a call is ended between the originator terminal and the recipient terminal. Chavez, however, teaches using switching network circuits to detect customer responses when the parties are finished with the conversation (column:line 3:42-49; patent citations hereafter by number only). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone advertisement method of Kim

and the post-call data collection of Chavez in order to further enhance an advertisement effect and generate revenue during call time that is otherwise not generating revenue (Kim at 0006, Chavez at 1:47-51).

As to claim 3, Kim and Chavez further disclose the method of claim 1, wherein the advertising data are at least one of character messages, drawing messages, picture messages, moving pictures, and files (Kim at 0008, counting the number of listening and watching of an advertisement; Chavez at 3:42-46, detect a positive response).

As to claim 4, Chavez further discloses the method of claim 3, wherein the step of transmitting the extracted advertisement data further comprises the step of transmitting, together with the advertisement data, connection information to connect the originator terminal with the advertising administration agency server or an advertising sponsor server (3:42-56, detect positive response, control processor places call to terminal set and terminates to either call center designated by advertiser or provide additional message via synthesizer).

As to claim 5, Kim further discloses the method of claim 1, wherein the step of extracting advertisement data further comprises the steps of:  
extracting originator and recipient information from the call request signal (0031, ascertains authentication code assigned to subscriber of a caller side, and recognizes a desired number and parses the number); and

determining if the originator or the recipient is a member using the originator and recipient information (0031, ascertains authentication, and if the number is one of the numbers subscribed).

As to claim 6, Kim further discloses the method of claim 1, further comprising the step of registering an advertising sponsor prior to the receiving a call request signal (0009, prestored advertisements; also 0019, advertisements provided from advertisers as a database).

As to claim 7, Kim further discloses the method of claim 6, wherein the step of registering an advertising sponsor further comprises steps of:

receiving a member admission request signal from an advertising sponsor server (0021, advertisement database provided from advertisers; the Examiner notes that an advertiser providing advertisements for a database would need to provide them through a server);

transmitting a member admission approval signal to the advertising sponsor server (0021, advertisement database; the Examiner notes that approval is either explicit or implicit in the inclusion of the advertisements within the database); and

receiving and storing advertisement messages and advertisement data from the advertising sponsor server (0021, advertisement database for storing advertisements such as music data or messages which are provided by advertisers).

As to claim 10, Kim further discloses the method of claim 1, further comprising registering a subscriber terminal as a member when a member admission request signal is received from the subscriber terminal (0021, member database for subscribers' information subscribed via Internet, telephone and facsimile).

As to claim 11, Kim further discloses the method of claim 10, further comprising receiving the input of desired advertisement type from the subscriber terminal, and storing the selected advertisement type (0021, the user downloads the advertisement and stores it in the phone terminal).

As to claim 12, Kim further discloses the method of claim 11, wherein a subscriber that joins as a member may individually and at any time apply for and revise advertising of a desired advertising sponsor using his or her terminal or through a website of a common carrier or an advertising administration agency (0022, a subscriber accesses system through browser, an existing member confirms download acceptable message).

As to claim 13, Kim further discloses the method of claim 11, wherein the extracting an advertisement message comprises extracting advertisement type information corresponding to the subscriber terminal (0022, operator server manages system so advertiser object and user are identified with each other).

As to claim 14, Kim further discloses the method of claim 10, wherein the step of registering a member further comprises the steps of:

receiving a transmitting advertisement member request signal that allows a subscriber to receive advertisement messages when the subscriber will be transmitting from the subscriber terminal (0021, advertisement database provided from advertisers); and

storing subscriber terminal information in a transmitting advertisement member database (0021, member database for subscribers' information).

As to claim 15, Kim further discloses the method of claim 10, wherein the step of registering a member further comprises the steps of:

receiving a receiving advertisement member request signal that allows an originator to receive advertisement messages when the originator will be transmitting to the subscriber terminal (0020, a user is subscribed as a member to receive an advertisement service); and

storing subscriber terminal information in a receiving advertisement member database (0021, member database for subscribers' information).

As to claim 16, Kim further discloses the method of claim 10, wherein the step of registering a member further comprises the steps of:

receiving a transmitting/receiving advertisement member request signal that allows a subscriber and an originator to receive advertisement messages, the

subscriber receiving advertisement messages in the case where the subscriber transmits from the subscriber terminal and the originator receiving advertisement message in the case where the originator will be transmitting to the subscriber terminal (0009, make a caller and a receiver listen to or watch the advertisement); and  
storing subscriber terminal information in a transmitting/receiving advertisement member database (0021, member database for subscribers' information).

As to claim 18, Kim further discloses the method as in claim 1, further comprising the steps of:

receiving a purchase information request signal from an originator terminal (0008, method comprising purchasing a product of a sponsor of the advertisement; also 0019, enabling users to purchase);

extracting purchase information corresponding to the advertisement data (0008, providing advantages with respect to the advertisement and purchase; also 0035, verifying member on purchase); and

transmitting the purchase information to the originator terminal (0008, providing advantages; also 0035, authenticates a benefit; the Examiner notes that the form and amount of advantages or benefits would necessarily be communicated or transmitted).

As to claim 19, Kim further discloses the method of claim 18, wherein the purchase information includes at least one of estimate information, drawings, pictures, moving pictures, files, and catalog information (0019, on-line commercial transaction

system, and 0035, on-line commerce system; the Examiner notes that an on-line commerce system would necessarily include pricing/estimate information, catalog information, and/or encompass a file transfer).

As to claim 20, Kim further discloses the method of claim 18, wherein in the case where the advertisement message is music (0021, music data), but does not explicitly disclose the purchase information is CD information that includes music. Kim, however, does teach purchasing downloaded music in relation to the ring back tone advertising, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the purchase of music in relation to ring back tone advertising per Kim in the form of a CD rather than a download in order to further enhance an advertisement effect per the teaching of Kim (0006).

As to claim 21, Kim further discloses the method of claim 18, further comprising the steps of:

receiving a purchase request signal that includes information of a purchase product from the originator terminal (0035, user purchases a product in a cooperative commerce system)

processing a purchase order of the purchase product based on the purchase request signal (0035, discount benefit at a bill issued).

As to claim 22, Kim further discloses the method of claim 21, further comprising the steps of:

renewing and storing the accumulated points of the originator (0032, point accumulation); and

transmitting renewed accumulated point information to the originator terminal (0032, accumulate points provided when subscriber wants).

As to claim 23, Kim further discloses the method of claim 1, further comprising the steps of:

receiving a purchase request signal that includes information of a purchase product from the originator terminal (0035, user purchases a product); and

processing a purchase order of the purchase product based on the purchase request signal (0035, discount benefit at a bill issued).

As to claim 25, Kim further discloses a system for providing an advertisement service using a ring back tone, comprising:

a receiver receiving from a common carrier a call connection request signal of an originator terminal (0019, users at an outgoing call signal side, and when an existing terminal is used);

a member management unit extracting information of an originator and a recipient from the call connection request signal to determine if the originator or the recipient is a member, and managing member information (0031, authentication code and parse telephone number; also 0021, member database);

an advertisement message extracting unit extracting advertisement messages to be transmitted from an advertisement message database (0019, advertisement database, operator server controlling the system);

an advertisement data extracting unit extracting advertisement data from the advertisement database (0021, member database used for selecting advertisement); and

a transmitter transmitting an advertisement message extracted in the advertisement message extracting unit to the originator terminal through the common carrier (0008, outputting the advertisement as ringing tone to a caller) after a member authorization signal is received from the member management unit (0031, authorization code).

Kim, however, does not explicitly disclose transmitting advertisement data when a call between the originator and the recipient is ended. Chavez, however, teaches providing advertisement information when a call is abandoned, either by answering the call or failing to answer (3:42-49). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone advertisement method of Kim and the post-call data collection of Chavez in order to further enhance an advertisement effect and generate revenue during call time that is otherwise not generating revenue (Kim at 0006, Chavez at 1:47-51).

As to claim 26, Kim further discloses the system of claim 25, further comprising:

a purchase information extracting unit extracting purchase information from a purchase information database (0035, user purchases a product in cooperative on-line commerce system, and discount notified and deposited, with benefits selected according to system operator policy; the Examiner notes that the transaction information would necessarily be stored, accessed and extracted from a database); and

a purchase processor performing purchase processing of a purchase product in the case where a purchase request signal that includes purchase product information is received from the originator terminal, the purchase processor performing this task based on the product information (0035, user purchases a product in cooperative on-line commerce system, and discount notified and deposited, with benefits selected according to system operator policy).

As to claim 27, Kim further discloses the system of claim 25, wherein the advertisement information includes at least one of character messages, moving pictures, and files (0019, various kinds of advertisements such as music data, messages, and motion pictures).

Claims 2, 28-31, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez in view of Kim.

As to claim 2, Chavez discloses a method for providing an advertisement service using a ring back tone in an advertising administration agency server, comprising:

receiving a call request signal of an originator terminal from a common carrier (1:56-61, when a call is placed);  
extracting an advertisement message from an advertisement database (3:25-28, processor accesses an internal table; also 4:1-3, plurality of advertisements that could be played);  
the advertisement message being transmitted to the originator terminal through the common carrier (1:56-61, public service provider transmits);  
interrupting transmission of the advertisement message when a call connection signal is received from the common carrier (3:25-29, advertisement transmitted during the period of time before terminal set 106 answers the call);  
extracting advertisement data corresponding to the advertisement message when a call completion signal is received from the common carrier (3:42-56, detect a positive response, and customer indicated that they wished additional information); and  
transmitting the extracted advertisement data to the common carrier, the advertisement data being transmitted to the originator terminal through the common carrier (3:57-67, control processor transfers subsequent call set up, and control processor instructs voice synthesizer to play additional information).

Chavez does not explicitly disclose transmitting the advertisement message to the common carrier, but does teach that the advertiser can pin point their advertisement to a target market (2:32-34) thereby indicating origin or source. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone advertisement method and the advertisement origin and targeting of

Chavez to achieve transmission in order to further enhance an advertisement effect and generate revenue during call time that is otherwise not generating revenue (at 1:47-51).

As to claim 28, Chavez further discloses the method of claim 2, wherein the advertising data are at least one of character messages, drawing messages, picture messages, moving pictures, and files (5:53-55, data message may be multi-media video and sound).

As to claim 29, Chavez further discloses the method of claim 2, wherein the step of extracting advertisement data further comprises the steps of:

extracting originator and recipient information from the call request signal (2:64-66, switching network provides all necessary switching functions; also 3:16-20, provides dial tone to terminal set 106 and receives dialing information defining the number of terminal set 107); and

determining if the originator or the recipient is a member using the originator and recipient information (4:16-21, determine if call setup message received, if no, normal processing of call; also 2:9-14, customers of public service provider).

As to claim 30, Chavez further discloses the method of claim 2, further comprising the step of registering an advertising sponsor prior to the receiving a call request signal (3:25-29, access internal table to determine advertisement, and 4:1-3, plurality of advertisements that could be played; the Examiner notes that a table

containing a plurality of advertisements requires or constitutes a registry of advertising sponsor(s)).

As to claim 31, Chavez further discloses the method of claim 2, further comprising registering a subscriber terminal as a member when a member admission request signal is received from the subscriber terminal (2:9-14, customers of public service provider).

As to claim 33, Chavez discloses the method as in claim 2, but does not explicitly disclose further comprising the steps of: receiving a purchase information request signal from an originator terminal; extracting purchase information corresponding to the advertisement data; and transmitting the purchase information to the originator terminal. Kim, however, teaches enabling users to purchase (0019), and providing advantages (0008), verification (0035), and authenticating benefits (0035) for a purchase transaction. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone advertisement method of Chavez and the purchase transaction function and notice of Kim in order to further enhance an advertisement effect and generate revenue during call time that is otherwise not generating revenue (Chavez at 1:47-51, Kim at 0006).

As to claim 34, Chavez discloses the method of claim 2, but does not explicitly disclose further comprising the steps of: receiving a purchase request signal that

includes information of a purchase product from the originator terminal; and processing a purchase order of the purchase product based on the purchase request signal. Kim, however, teaches enabling users to purchase products (0035) and confirming a discount benefit when a bill is issued (0035). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone advertisement method of Chavez and the purchase transaction function and notice of Kim in order to further enhance an advertisement effect and generate revenue during call time that is otherwise not generating revenue (Chavez at 1:47-51, Kim at 0006).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Roth et al. (U.S. Patent No. 6,285,987, hereafter Roth).

As to claim 8, Kim discloses the method of claim 7, but does not explicitly disclose wherein the step of receiving and storing advertisement messages and advertisement data further comprises the step of receiving and storing information of advertisement message transmission time periods from the advertising sponsor server. Roth, however, teaches storing data about advertiser such as start and/or end time (10:55-60), therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the sponsor registration for ring back tone advertising of Kim with the time period designation of Roth in order to further enhance an advertisement effect and decide which advertisement to display to a viewer (Kim at 0006, Roth at 2:7-10).

As to claim 9, Roth further discloses the method of claim 8, wherein the step of receiving and storing information of advertisement message time periods further comprises the steps of:

receiving a bidding price from the advertising sponsor server (2:20-23, proposed bids);

classifying and storing advertising sponsor information and transmission time period information according to time period (10:55-60, Data About Advertisers, Time-Start/End, and advertiser ID);

selecting an advertising sponsor with the highest bidding price as a successful bidder for each transmission time period (2:58-60, selection logic selects highest bid from available bids); and

transmitting successful bid information to the servers of the selected advertising sponsors (13:39-40, transmit information to the log and billing unit; the Examiner notes that this billing information would necessarily, then, be transmitted to the selected advertiser).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Agmoni (U.S. Patent Application Publication No. 2002/0010626).

As to claim 17, Kim further discloses the method of claim 1, but does not explicitly disclose wherein the step of extracting an advertisement message from an

advertisement database further comprises the steps of: extracting a present position of the originator terminal; extracting an area advertising sponsor corresponding to the present position; and extracting advertisement messages corresponding to the area advertising sponsor. Agmoni, however, teaches delivery of targeted advertising based on identifying the likely physical location of a user derived from telephone data and technologies. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ring back tone targeted advertising of Kim with the location-based targeted advertising of Agmoni in order to further enhance an advertisement effect and increase effectiveness of directed advertisements (Kim at 0006, Agmoni at 0011).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez in view of Agmoni.

As to claim 32, Chavez discloses the method of claim 2, but does not explicitly disclose wherein the step of extracting an advertisement message from an advertisement database further comprises the steps of: extracting a present position of the originator terminal; extracting an area advertising sponsor corresponding to the present position; and extracting advertisement messages corresponding to the area advertising sponsor. Agmoni, however, teaches delivery of targeted advertising based on identifying the likely physical location of a user derived from telephone data and technologies. Therefore it would have been obvious to one of ordinary skill in the art at

the time of the invention to combine the ring back tone targeted advertising of Chavez with the location-based targeted advertising of Agmoni in order to generate revenue during call time that is otherwise not generating revenue and increase effectiveness of directed advertisements (Chavez at 1:47-51, Agmoni at 0011)

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is (571)270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SDG  
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